



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/929,836	09/15/1997	RUSSELL DONOVAN ARTERBURN	6971	2308
7590	04/26/2004		EXAMINER	
ROBERT D. TOUSLEE JOHNS MANVILLE CORPORATION 10100 WEST UTE AVENUE LITTLETON, CO 80127			HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 04/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	08/929,836	ARTERBURN, RUSSELL DONOVAN
	Examiner	Art Unit
	John Hoffmann	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 4/12/04.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1,3 and 5-7 is/are allowed.
- 6) Claim(s) 2,4 and 8-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 16-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 16 lines 4-5 require that the first screen have uniform hole size and density, "at least some of the holes have a diameter". There is no basis for this limitation of only some of the holes having a diameter. First it is noted that there is no explicit basis for these two things. As to any implicit support, examiner could not find any. On the contrary, if the holes are of uniform size and density, all the holes would have to be substantially the same. This is a *prima facie* showing of failure to comply with the written description requirement. The burden is now on Applicant to overcome the showing.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2,4, 8-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16, line 5 requires uniform hole size and density. But line 6 only requires at least some of the holes having the diameter. Examiner does not understand this, because if the some of the holes did not have a diameter, then the holes would not have a uniform size and diameter. They would be of different sizes.

Claim 23, line 5 has a period after "channel". It is unclear as to whether it should be comma, and if not, how one should interpret the claim.

The "portions" of claim 2,4 8-15, and 21-24 are indefinite as to their meaning. During the prosecution of this invention, Examiner interpreted the claims as follows: "Anyone can designate any section, sub-section, sub-subsection or sub-sub-sub-section near an end to be an 'end portion' simply because it is a 'portion' near an end. Applicant and the Board disagreed with this assessment. If a portion cannot be arbitrary, then it must be specific. Examiner is at a complete loss as to how to determine from the prior art as to whether a portion (that is at the end of a screen) is or is not an "end portion".

Since Examiner cannot determine the scope of "end portion", Examiner cannot ascertain whether the present "end portions" result in a novel and unobvious invention. Furthermore, one of ordinary skill would not be able to tell whether their portions that

occur at the end of a screen constitute an "end portion". The same problem applies to "central portion".

Response to Arguments

Applicant's arguments filed 4-12-04 have been fully considered but they are not persuasive.

It is argued that the Board did not determine that Examiner could not arbitrarily designate various portions of the screen so that one end portion is smaller in area than another end portion. This is incorrect. Page 11, lines 7-10. of the Decision on Appeal states "...it is inappropriate for the examiner to "arbitrarily" define or designate various portions of the prior art apparatuses to achieve the claimed invention."

It is also argued that applicant should not be required to specify the area of the end portions or the mid or central portions. Applicant is not so required. Examiner apologizes if such an impression was given. If anything, such is merely one way to overcome the rejection. Clearly there would be other ways to overcome the rejection. For example, removing all mention of all portions. It is noted that this is not an invitation to do so at this point. Such an amendment would likely raise new issues and would not be entered.

It is argued that the specification describes "end portion" as being on one side of the central portion. A description is somewhat irrelevant as to what a definition is. One can describe a dog as being a four-legged mammal, but that is not a definition of "dog". Likewise, Applicant's description, is not determined to be a definition. When an

Art Unit: 1731

applicant is acting as a lexicographer, the applicant must clearly set forth that a term is being defined. Even if it was Applicant's intention for the description to be a definition, there is a lack of clear indication that it was to be a definition. Most importantly, this argument by applicant is not well taken because such a definition would encompass what Examiner had previously considered to be end portions in Stalego. Since Applicant and the Board determined that Stalego did not have end portions, one must conclude that the relevant portions of Stalego's screens do not fall within the defintion of "end portion" (whatever that definition is).

It is also argued that the Board did not indicate the "end portion" term was indefinite. The Board indicated that "various terms" were indefinite and that the Examiner and Applicant should correct such problems. The "end portion" language is one of the various indefinite terms.

The ultimate question is: Why are portions of screen on Stalego's screen not "end portions"? Applicant wants one definition for "end portion" for Applicant's invention, but wants a completely different definition for the prior art's screens. It the Office's responsibility to make sure the claims set forth what the invention is, so that a potential infringer can determine whether or not he is infringing. Presently, one of ordinary skill who has a screen that is half-cross between Applicant's screen and Stalego's screen would be unable to determine whether or not he has "end portions".

Most importantly, Applicant's arguments/definition is not well taken because Stalego has "end portions" (as per Applicant's present unacceptable definition), but the Board and Applicant have both determined Stalego does not have "end portions". How

Art Unit: 1731

can Stalego have end portions in 2004, but not have end portions in 2003? Examiner will not allow the claims in question with such a contradiction in the record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

Art Unit: 1731

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John Hoffmann
Primary Examiner
Art Unit 1731

4-21-04

jmh